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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,128	03/22/2002	David Hodgson	PT-1066 USN	2538
27904	7590	12/15/2004	EXAMINER	
INCYTE CORPORATION EXPERIMENTAL STATION ROUTE 141 & HENRY CLAY ROAD BLDG. E336 WILMINGTON, DE 19880			WILDER, CYNTHIA B	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/089,128

### Applicant(s)

HODGSON ET AL.

### Examiner

Cynthia B. Wilder, Ph.D.

### Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, 12 and 16-19, drawn to an isolated nucleic acid, method of making and using said isolated nucleic acid.

Group II, claim(s) 11, drawn to transgenic organism.

Group III, claim(s) 13, drawn to isolated polypeptide.

Group IV, claim(s) 14, drawn to antibody.

Group V, claim(s) 15, drawn to protein binding assay to identify compound.

### **Sequence Election Requirement Applicable to All Groups**

3. In addition, each Group detailed above reads on patentably distinct sequences (SEQ ID NOS:). Each sequence is patentably distinct because the sequences are structurally distinct, and a further restriction is applied to each Group. Applicant must further elect a single sequence (SEQ ID NO:) from the group consisting of SEQ ID NOS: 1-71. Applicant must specifically identify each of the corresponding SEQ ID NO: X or SEQ ID NO: Y for the sequence elected along with the corresponding elected claims.

**Applicant is advised that examination will be restricted to only the elected SEQ ID NO: and should not to be construed as a species election.** Non-elected sequences in multiple sequence claims will be withdrawn from prosecution.

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2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The claims of Group I are sufficiently broad to encompass a nucleic acid taught in the prior art. Accordingly, the invention does not represent a contribution over the prior art because the art teaches a polynucleotide sequence complementary to the sequence of SEQ ID NO: 2 (US 5972660, Sequence 2) as required by the invention of Group I. The claims lack a special technical feature that is the same or that corresponds to a special feature of the other claimed invention. Thus, there is not a special technical feature linking the recited groups, as would be necessary to fulfill the requirements for unity of invention.

Further Groups I-IV are drawn to distinct products lacking the same or corresponding technical features. The nucleic acid of group I is composed of nucleotides and can function in methods of nucleic acid hybridization and/or amplification, whereas Group II is drawn to a transgenic animal, a complex organism that is employed in e.g., animal research methods and models. Such organisms cannot be employed and e.g., probes or primers, and/or peptide. The transgenic animal of differs in structure from the products of Groups I, III and IV. The polypeptide differs from the invention of Group I, II and IV in that is composed of amino acids linked by peptide bonds and function in methods of ligand bindings assay, and the antibody differs from the other inventions in that the antibody is composed of amino acids linked by peptide bonds. Antibodies are glycosylated and their tertiary structure are unique, where four subunits associated via disulfide bonds form into a Y-shaped symmetric dimer. The antibodies can function in immunoassays. The different invention are distinct one from the other.

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Further the Group V drawn to a method of screening for a compound using a protein binding assay differs from the nucleic acid and method of making and using of Group I and the transgenic animal of group II, the polypeptide of Group III and the antibody of Group IV. The method of Group V have different objectives, method steps and results in different effects from the inventions of Groups I-IV. Therefore, it is again noted that the claims of the present invention are not directed to the same or corresponding special technical feature for the reasons discussed above.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be emailed to [cynthia.wilder@uspto.gov](mailto:cynthia.wilder@uspto.gov). Since email communications may not be secure, it is suggested that information in such request be limited to name, phone number, and the best time to return the call.

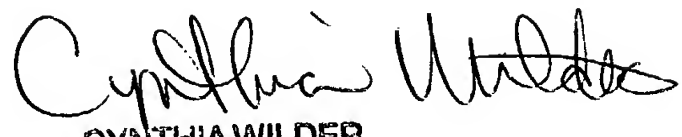
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
CYNTHIA WILDER  
PATENT EXAMINER  
12/1/2004